

REMARKS

This Amendment, filed in reply to the Office Action dated January 27, 2009, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-7, 9-16, 18 and 47-51 are all the claims pending in the application.

I. Claim Rejections under 35 U.S.C. § 112

Claims 8, 17, 45, and 46 stand rejected under 35 U.S.C. § 112, second paragraph. By cancellation of these claims, this rejection is rendered moot.

II. Claim Rejections under 35 U.S.C. § 103

Claims 1-18 and 45-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burgess (U.S. Patent No. 5,695,859) and Reeb (U.S. Patent No. 4,792,790) further in view of Takeuchi et al. (U.S. Patent No. 5,852,337). Applicant respectfully submits the following arguments in traversal of the rejections.

Claim 1 describes plural communication units connected to the first conductive layer and the second conductive layer, wherein the first communication element of the plurality of communication elements initiates transmission to a second communication element of the plurality of elements. The Examiner cites to Fig. 10 and col. 14 of Burgess to teach this aspect of the claims. In general, Burgess relates to a sensor pad, formed with a first and second conductive layer. The sensor pad is used to switch machinery on and off on the floor of a factory. Contact between the first and second conductive layer, through a pressure-sensitive layer, acts as a switch to trigger machinery on and off. Several embodiments of the sensor pad are disclosed. The cited Fig. 10 and column 14 of Burgess discusses the disposition of a cone shaped member 72a which becomes deformed under the weight of a factory worker. The

deformed cone comes into contact with the electrical member 74a. The direction of displacement (as made evident with the electrical signal of the member 74a to underlying electrode 74b) helps determine magnitude and shear direction. By contrast, the downward force depends on the magnitude of voltage between the member 74c and electrode 77. It is apparent that no arrangement of the various conductor elements 74a-c and 77 can meet the requirements of the first and second conductive layers, having plural communication elements connected thereto. For example, plural elements 74a are not connected to any element that comprise first and second conductors and do not communicate with other plural elements 74a.

Moreover, no part of col. 14 describes that the second communication element acknowledges a change in voltage propagated around the first communication element as a signal. As discussed above, the electrodes 74a simply do not communicate information with each other. In fact, since the cone 72a will deform in only a particular direction under weight of a user, only one of such electrodes 74a will ever be activated by the individual cone 72a. The signal of the electrode 74a may be detected by electrode 74b, for example, but the electrode 74a and 74b are not connected to first and second conductors in common. Therefore, the Examiner's rejection is incorrect for at least these reasons.

In addition to the above deficiencies, the Examiner's rejection improperly combines features of Burgess Figs. 1, 2 and 10 in rejecting claim 1. See Office Action, page 4. The Examiner cannot combine different embodiments without motivation to do so. In re Kramer, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991); Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003).

The Examiner does correctly concede that Burgess fails to teach a second communication element is assigned an ID identifying the element and that the communicated signal includes an ID identifying a recipient communication element to subsequently receive a signal. The

Examiner cites Reeb to make up this deficiency. However, Reeb is clearly unrelated to the present invention and is also clearly unrelated to the primary Burgess reference. Therefore, the reliance on Reeb cannot support the rejection. More particularly, Reeb relates to forming an RC resonance circuit in a simple form to tag articles. The emission of the RC frequency helps keeps items, such as items in a store, secure against theft. See Reeb, col. 1, lines 11-21; col. 2, lines 40-45. The Examiner's citation to col. 19 and Fig. 30 of Reeb merely describes the adjustability of the RC signal. Even assuming *arguendo* that the RC emissions of Reeb comprise an ID, they do nothing to identify a recipient of a signal. The tags (alleged communication elements with ID) of Reeb also clearly are not attached to first and second conductive layers in any manner as required by claim 1. There would simply be no basis to make such a connection to common first and second conductor layers in Reeb. The Examiner has completely failed to provide any motivation to include a tag identifier of Reeb with the pressure sensor pad of Burgess.

The Examiner also correctly concedes that Burgess and Reeb fail to teach plural communication elements placed for communication without individual conductive wires. The Examiner cites the piezoelectric film of Takeuchi to make up for this deficiency. However, the cited piezoelectric film will inherently have individual contacts in order to convert the mechanical energy to electrical energy and vice versa.

Finally, the rejection of claim 1 is improper because the Examiner is improperly relying on Applicant's own disclosure. The Examiner's stated motivation to combine Burgess, Reeb and Takeuchi is to provide identification of units in a wireless manner. However, this motivation is drawn from the present specification at pages 3-4. However, in a proper rejection, both the suggestion and the reasonable expectation of success must be found in the prior art, not in the

applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442-3 (Fed. Cir. 1991). The Examiner has not met that burden here.

For all the above reasons, the rejection of independent claim 1 should be withdrawn. Claim 10 is patentable for analogous reasons, and the remaining claims are patentable based on their dependencies.

With further regard to claims 4 and 13, these claims describe that the ID includes the originating source. The Examiner alleges that Reeb teaches this feature. However, no aspect of Reeb requires that a transmission signal include the originating source. For example, in order to prevent theft (removal of an article from a store), it is not necessary to know the source of a signal. It is sufficient to know that one (of many) tagged articles is being removed. Therefore, there is no requirement in Reeb that the originating source ID be included in the signal. Claims 4 and 13 are patentable.

With regard to claim 5 and 14, these claims describe communication among neighboring communication elements. The Examiner cites cols. 2 and 15 of Burgess as teaching this feature. The cited col. 2 merely teaches generally the more detailed embodiment of Fig. 10, col. 14. As discussed above, any electrode 74a-c does not communicate with neighboring communication units connected to conductive layers. At best, 74a communicates with electrode 74b, and electrode 74c communicates with electrode 77. However, these various electrodes do not meet the connection to the (common) first and second conductive layers as required by the base claim. Claims 5 and 14 are patentable.

With further regard to claim 47, this claim specifies that the plural communication elements do not overlap each other in the direction of disposition of the first and second layers. The Examiner cites a vertical stack of Burgess to teach features of claim 47. However, the cited

portion of Burgess teaches the exact opposite of claim 47. Claim 49 is patentable for analogous reasons.

Claim 51 is added to describe the communication units more specifically.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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